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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,900	06/26/2001	Kai H. Chang	2-8-23	2416

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Michael A. Morra
Suite 2H-02
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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/891,900

Applicant(s)

CHANG ET AL.

Examiner

John Hoffmann

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____

13. ☒ Other: The rejection would be the same as in the final - the scope of the claims has not changed

[Signature]
John Hoffmann
Primary Examiner
Art Unit: 1731

Continuation of 5. Applicant's reply has overcome the following rejection(s): The 112 rejection based on the markush groups- except for those of claims 13 and 15.

Continuation of 11. does NOT place the application in condition for allowance because: The arguments were not convincing.

As to the statement that the method includes "making an adjustment to the atmosphere in which one of those process steps is performed", the claims do not require such. It is clear that the adjusting (step g) occurs after all of the steps (a-f). Again the claims do not claim what applicant says the invention is (see rejection). Examiner notes that Applicant further states that the atmosphere is one that "will have been adjusted". Applicant's arguments appear to contradict each other.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, applicant's argument that nothing in Powers suggests reducing aging loss is largely irrelevant. The Office has never asserted Powers teaches anything about aging loss. Blankenship has the necessary hydrogen aging teachings.

It is further argued that nothing in Powers suggests monitoring oxygen levels in any process steps other than the consolidation step. The relevance of this is not understood; the claims do not require monitoring or determining oxygen levels.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is deemed that the rejection is substantially based on modifying the teachings of the prior art; not "combining". The rejection clearly points out the motivation and the evidence that one of ordinary skill would be aware of this motivation.

It is argued that the two references are concerned with completely different issues. This is presumed to be irrelevant. The rejection is not based on issues or concerns of the prior art per se. The rejection is based on the teachings found in the prior art. Rejections need not be limited to issues and concerns in the prior art.

It is further argued that nothing in Powers suggests adjusting partial pressure for dehydration steps based on how aging has affected previously produced fibers. The relevance of this not pointed out in the arguments. The rejection does not state or reasonably suggest that Powers suggest such a teaching. See the rejection for why the invention is held to be obvious.

As to the argument bridging pages 11-12 of the response: this is deemed to be irrelevant because the claims do not require adjusting the pressure of hydrogen.

As to the assertion that the rejection is based on an over-simplification of the fiber making method. If this is true, then it is only because the claims only specify an over-simplification of the fiber-making method.

It is noted that applicant argues that "too many variables and process parameters" to perform routine experimentation as indicated in the rejection. There is no evidence to support such an allegation. It is noted that any such evidence used may be used to reject applicant's claims based on non-enablement; It appears that Applicant has not specified but a few of the many variables and parameters which would suggest that one could not make and use the present invention with mere routine experimentation..